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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

03409.0066

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on _____

Signature _____

Typed or printed name _____

Application Number

09/842,051

Filed

April 26, 2001

First Named Inventor

Masahiko Miyamoto

Art Unit

Examiner

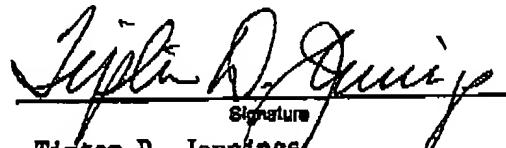
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/95) attorney or agent of record. 20,645
Registration number _____ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Tipton D. Jennings

Typed or printed name

571.203.2750

Telephone number

October 25, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required; see below.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 122. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT: Mail Stop AF
Customer No. 22,852
Attorney Docket No. 03409.0066

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
Masahiko MIYAMOTO) Group Art Unit: 3711
Application No.: 09/842,051) Examiner: Sebastiano Passaniti
Filed: April 26, 2001) Confirmation No. 6514
For: GOLF CLUB HEAD)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop AF

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections applied against claims 1, 3, 4, 6, and 12-15 in the final Office Action dated July 25, 2005. This submission complies with the requirements for requesting a pre-appeal brief review as set forth in the Official Gazette Notice, July 12, 2005.

I. Status of the Claims

All claims 1, 3, 4, 6, and 12-15 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Werner (U.S. 6,139,445) in view of applicant's own disclosure, i.e., Comparative Example 7-Table 1, page 9, which the Examiner misconstrues as "prior art." Additionally, the Examiner argues three patents not formally cited in this rejection. These patents are Masghati (U.S. 4,471,961) (Final Rejection ("FR"), page 5), Yoshida (U.S. 5,569,337) (FR, page 7), and Yamashita (U.S. 5,378,295) (FR, page 7).

Claims 1, 12, 14, and 15 stand finally rejected as unpatentable on six patents under 35 U.S.C. § 103(a), namely, Yim (U.S. 6,183,380) in view of Thomson (U.S. 4,162,074), Lawton (U.S. 1,525,137), Gordos (U.S. 4,065,133), Rozmus (U.S. 3,966,210), and Doran (U.S. 4,872,683); and dependent claims 4 and 13 on the same six patents plus Reuter (U.S. 3,652,093).

II. Grounds for Traversing Final Rejection**A. It Is an Error In Fact to State that a Disclosure of a Comparative Example is an Admission of Prior Art**

The invention relates to a wood-type golf club head which prevents loss of carry due to reduction of the launching angle and suppresses variance of carry caused by the difference in the position where the golf ball is struck. The term "carry" is incompatible with a putter which is primarily used to roll a ball along the ground. As shown in application Fig. 1, the sweet spot serves as a border or boundary line that divides the face of the wood-type golf club head into upper and lower portions. On page 4, beginning at line 17, the application states that if the upper roll radius R_1 of the upper portion 2a exceeds 305 mm, carry at the upper ball striking position is reduced; and if the roll radius R_2 of the lower portion 2b is less than 310 mm, carry at the lower ball striking position becomes insufficient.

Each of the three independent claims 1, 14, and 15 calls for this wood-type golf club head and a face surface having upper and lower portions "separated by a boundary line across the position of a sweet spot on the face surface." Each claim calls for a roll radius at the upper portion of 305 mm or less and at the lower portion of 310 mm or more.

The Pilot Program states that one goal is to identify the presence of a clearly improper rejection based upon an error in fact. It is an error in fact to presume that the use by an applicant of comparative examples in a patent application while describing his invention is an admission of prior art or a recognition by the applicant that this disclosure of comparative examples is prior art, where there is neither a statement to this effect nor any other admission that these examples are well known in the art.

Beginning on page 5, line 8 of the final Office Action, the Examiner attempts to modify the patent to Werner, which he admits is deficient, by relying on "upper and lower roll radii" of applicant's own Comparative Example 7. In order for his reliance on applicant's disclosure to be

sustained, the Examiner must identify the place in the application where Comparative Example 7 is said to be known or prior art. The Examiner has failed to do so because there is no such statement, and, accordingly, the rejection is erroneous because it is based on an error in fact. (Applicant submits that it is unnecessary, in traversing this final rejection, to discuss further what Werner or what the patent to Masghati discloses. Note that Masghati was not cited in the rejection but was used by the Examiner to bolster his argument-FR, page 5, beginning on line 20.)

In the Reply to Office Action filed May 9, 2005, applicant pointed out this error beginning on page 6, line 5, and even requested the Examiner, if he chose to continue with this rejection, to identify, in this factual situation where there is no admission of prior art, the part of 35 U.S.C. § 102 that establishes that Example 7 is prior art.

This request has fallen on deaf ears. Instead of responding, the Examiner attempts to establish without factual or legal support a general rule based on the “golf club arena” being “replete with teachings” that the language “comparative example” or “comparative sample” is “recognized as referring to that which is already known.” (FR, page 7, lines 3-7). He then erroneously concludes (lines 15-18) that “it is deemed that applicant’s use of the language ‘comparative example’ does indeed connote and establish that the material disclosed by the applicant as a comparative example is actually prior art.” To support this strained conclusion and to bolster the final rejection, the Examiner refers to the patents to Yoshida and Yamashita, neither of which was cited in the actual rejection. However, the Examiner is defeated here by his own statements. He admits that Yoshida makes use of a known stainless steel as a comparative example, and that Yamashita’s prior comparative samples were prepared in accordance with known club head designs (FR, page 7, lines 7-15).

In contrast, there is no admission or statement by applicant that Comparative Example 7 is known or is prior art, and the Examiner could point to none. Regardless of what the “golf club

arena" ostensibly says, the disclosure of comparable examples in the subject application does not connote or establish that what is disclosed is prior art. Comparative Example 7 cannot be used as a reference, and this rejection must be withdrawn.

B. A Prima Facie Case of Obviousness Has Not Been Established in Rejecting Claims 1, 4, and 12-15 Based on the Yim Putter in View of Five or Six Secondary References

In the final rejection, the Examiner cites and uses for the first time three additional patents to Gordos, Rozmus, and Doran as secondary references in an attempt to transform the Yim putter into a golf club head not contemplated either by Yim or by the putters of Thomson, Lawton, and Reuter. Similar to his unsubstantiated position noted above in Section A, the Examiner attempts again to establish a general rule by arguing the art "is replete with examples wherein invention is extended to include clubs of the iron-type, putter-type and wood-type, as these are all clubs that are commonly employed by a golfer." (FR, page 2.) While there is no dispute that a golfer employs all three types of clubs, this fact does not control patent law or whether an invention limited by Yim solely to a putter can be rewritten to apply to a wood-type head.

As discussed by the Examiner, Rozmus, Gordos, and Doran all describe specific teachings for the use of their respective inventions in putters, drivers, and irons. Not so in Yim, who, by a clear reading of his patent, limits his invention to putters. Yim's purpose is to provide a dual-face striking surface to maximize the use of the sweet spot of the putter, regardless of the type of stroke used (col. 1, line 66-col. 2, line 3). The background, drawings, detailed description, and claims are all limited to putters.

The concept of carry or improving carry as employed in the present invention is foreign to Yim. Yim does not contemplate the solutions advanced in the present invention for the problems of loss and variance in carry. Attention is called to application Table 1 entitled "Result

of carry measurement." The lowest carry distance in this table is 144.3 meters, a distance so great in relation to putters, that a skilled artisan attempting to solve carry problems would not consider Yim or ever attempt to transform Yim, with its limited teachings directed solely to a putter, into a wood-type golf club head.

Thus, there is no prima facie case of obviousness because every claim requires a wood-type golf club head which Yim does not show, contemplate, or suggest; and no one skilled in the art would attempt to modify Yim into this type head because of the absence of any motivating suggestion to make this modification. Withdrawal of the rejections of claims 1, 4, and 12-15 is respectfully requested.

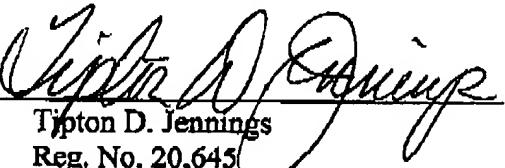
Although the rejections are also based on Thomson and Lawton (claims 1, 12, 14, and 15) and Thomson, Lawton, and Reuter (claims 4 and 13) in combination with Yim, Gordos, Rozmus, and Doran, in view of the absence of a prima facie showing as discussed above, it is submitted for purposes of this Request that it is unnecessary to repeat the additional distinguishing features of the claims set forth on page 5 of the Reply to Office Action of May 9, 2005.

III. Conclusion

Because the Examiner's rejections of claims 1, 3, 4, 6, and 12-15, include factual and legal deficiencies with regard to 35 U.S.C. § 103(a), applicant is entitled both to a pre-appeal brief review of the final Office Action and allowance of these claims.

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 25, 2005

By: 
Tipton D. Jennings
Reg. No. 20,645